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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,670	12/31/2003	Lionel Poincenot	28952.5628	2778

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

Office Action Summary	Application No. 10/748,670	Applicant(s) POINCENOT ET AL.	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4, 8, 13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-12, 14-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on 17 April 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/748,670 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 5-7, 9-12, 14-15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner is uncertain how the elected species is able to have an iron head where when in the address position with the toe raised (Fig. 2) the lowest point on the sole (SCP) is substantially vertically below the CG and the dynamic low point and the center of gravity lying in a centerline plane with the center line plane is substantially vertical. The examiner cannot see how both of these situations exist for figures 2, 1, or figure 7 (elected embodiment). There is no drawing which shows the centerline plane, center of gravity, dynamic low point and the static

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contact point. The examiner is unable to determine where these are located relative to one another. In figure 7 the center of gravity does not appear to be located along a centerline plane.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-7, 9-10, 12, 14-15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimazaki.

Shimazaki discloses an iron type head having a center of gravity (CG), a static contact point (SCP) on a sole, a SCP able to be vertically below a CG at an address position with no point lower than a SCP in the form of a golfer placing a head on a ground in this orientation (Figs. 6-7), an SCP and at least two other points substantially vertically below the CG defining a non-planar static contact surface area (SCA) in the form of the sole have a curved shape to it (Fig. 6), a SCP and at least one other point substantially vertically below the CG define a contact line (SCL) in the form of when the club is addressed as shown in figure 6 since as shown by figures 6-7 the lowest bottom

of the sole shows a straight line profile from the front to rear direction (Fig. 7), dynamic proper lie angle so that an imaginary centerline plane orthogonal to the plane of the club face and containing an imaginary centerline of the face has a center of gravity lying in the centerline plane and a dynamic contact low point on a sole also lying in the centerline plane when the center line plane is substantially vertical (Fig. 6, [0013], [0014]), the lowest point (LP) on a sole also lying substantially in a centerline plane when a center line plane is substantially vertical (Fig. 6), a non-planar lowest point surface area (LPA) comprised of points substantially vertically below a center of gravity when a centerline plane is vertical and no points of a sole are lower than the dynamic contact low point when a centerline plane is vertical (Fig. 6), and a head having both a SCA and a LPA (Fig. 6) by addressing a head differently for a SCA.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimazaki.

Shimazaki lacks a head having both a SCP and a LP with a SCP and at least one other point substantially vertically below the CG defining a static contact line SCL.

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Shimazaki discloses a profile for the face to the back having a straight configuration and contour lines near a toe end of a sole of a head having straight lines from the face to the back of a head (Fig. 7). Clearly an artisan skilled in the art of forming an iron head with a rounded sole from the heel to the toe would have selected a suitable profile from the face to the back of an iron at a sole other than where the sole contacts the ground in figure 6 in which a straight profile from the face to the back is included. It would have been obvious to modify the head of Shimazaki to have a head having both a SCP and a LP with a SCP and at least one other point substantially vertically below the CG defining a static contact line SCL in the form of the straight line from the face to the back in order to utilize a known method in the market place of forming soles from the heel to toe used in making golf club heads.

8. Claim 1-3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg, Chou, Antonious, Shaw, or Fujimura in view of Shimazaki.

Lundberg (Fig. 9), Chou (Fig. 6), Antonious (Fig. 2), Shaw (Figs. 4, 7, 10 and 12, (Col. 3, Lns. 20-27, and 60-63) or Fujimura (Figs. 1 and 3-4) disclose an iron type head with the center of gravity (CG) being heel biased and the sole being rounded and the heel able to be pivoted with the toe slightly raised in an address position until the center of gravity is in a substantially vertical plane containing a lowest point of a sole.

These references do not disclose the center of gravity being substantially vertical within that vertical plane over a static contact point which is the lowest point of the sole in this address position.

Shimazaki discloses a center of gravity in a forward to aft position being substantially over the middle of a sole and the sole be substantially flat in a forward to aft direction (Figs. 2-3 and 7). In view of the publication of Shimazaki it would have been obvious to modify the irons of Lundberg, Chou, Antonious, Shaw, or Fujimura to have a center of gravity in a forward to aft position being substantially over the middle of a sole in order to have a center of gravity location in the forward to aft direction used in the market place for irons. In view of the publication of Shimazaki it would have been obvious to modify the irons of Lundberg, Chou, Antonious, Shaw, or Fujimura to have a sole be substantially flat in a forward to aft direction in order to have a sole which assists the golfer in addressing the ball properly on the sole without having to try to balance a head also in the forward to after direction. As such the heel can be pivoted until the center of gravity is substantially vertical over a lowest point of a sole (SCP), a SCP and at least one other point substantially vertically below a CG would define a static contact line, and a SCP and at least two other points substantially vertical below the CG define a static contact surface (As stated in [00021] this can be a curved surface).

Response to Arguments

9. The argument that the reference of Shimazaki is improper due to Shimazaki does not disclose an address position which is not vertical but is tilted toward the heel of the head and the static contact point is heel biased and not in a centerline plane is

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disagreed with. How one addresses a head is related to how an apparatus is used. Shimazaki has a center of gravity location as disclosed in claim 6 with a rounded sole able to allow a heel to be pivoted to an address position just as shown in figure 2. In an apparatus claim, weight is given to what an apparatus is and not how it is used. The structure of Shimazaki is able to perform the functions as defined in the claims. The argument that the reference of Shimazaki is improper due to Shimazaki not teaching a static contact point lying substantially vertically below the center of gravity of the head is disagreed with. Shimazaki has the exact same location of the center of gravity as the elected embodiment of the applicant (Fig. 7) which is along a centerline orthogonal to a face (Claim 6). Clearly when the heel is pivoted to an address position with a new low point (SCP) on the sole, the static contact point of Shimazaki will lie as substantially vertically below the center of gravity as the applicant's static contact point. The argument that the reference of Shimazaki is improper due to Shimazaki having a dynamic low point toe-ward is disagreed with. If the head of Shimazaki was addressed and used as the applicant uses a head than it would not be having a toe-ward dynamic low point.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Beau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 5 June 2006



STEPHEN BLAU
PRIMARY EXAMINER